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REMARKS

Claims 1-6, 8-10, and 12-23 are presently pending in the captioned application. Applicants thank the Examiner for his indication in the Official Action that claims 11-12, 14, and 22-23 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants further thank the Examiner for the telephone conference of March 5, 2004, where the Examiner indicated the remaining claims not addressed in this assertion would be allowable if claim 1 was amended to include the limitations of claim 11. Accordingly, applicants have thus amended claim 1 and canceled claim 11 in accordance with the Examiner's suggestion.

Additionally, applicants have further amended claims 12, 22, and 23 so that they are no longer dependent on a canceled base claim. The amendments are presented in the expectation that the amendments will place this application in condition for allowance. The amendments do not introduce new matter within the meaning of 35 U.S.C. § 132. Accordingly, entry of the amendments is respectfully requested.

Regarding claim 14, applicants note that claim 14 was already in independent format. Accordingly, it is respectfully submitted that no further amendments to this claim are necessary for this claim to be allowed.

Further, applicants note that the present Official Action contains a new rejection to claim 17 under 35 U.S.C. 103(a) in view of the references previously cited against claims 1-10, 13, 16, and 18-21. However, MPEP § 706.07(a) clearly states that "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." In this regard, applicants note that the only amendment made to claim 17 in the last Response was to remove a multiple dependency. Further, applicants note that an information disclosure statement was not filed in the present application during the period set forth in 37 CFR 1.97(c). Accordingly, applicants respectfully assert that, since the outstanding Official Action contains a new ground of rejection not necessitated by applicants' claim amendments or a newly submitted information disclosure statement, the finality of the present Official Action is improper. Accordingly, applicants respectfully request the Examiner to remove the finality of the currently pending Official Action.

1. Claim for Foreign Priority

The Examiner has again objected to the claim for foreign priority for the following reasons:

> Applicant indicated that a certified copy of the foreign application, SG 200100727-7, has been filed; however no copy has been received. Thus, the requirement as set forth under 35 U.S.C. 119(b) has not been met.

As stated in the prior amendment, applicants have in fact actually filed a certified copy of the foreign application, SG 200100727-7, to which the present application claims priority in the present application. In this regard, the Examiner's attention is directed to the enclosed courtesy copy of the stamped filing receipt from the Patent Office mailroom of October 21, 2003 indicating that a certified copy of this application was received, as well as a courtesy copy of the front page of the submitted certified copy of this application. Accordingly, applicants respectfully assert that they are in full compliance with 35 U.S.C. 119(b) and respectfully request the Examiner to remove the outstanding objection and affirm the claim for foreign priority.

2. Rejection of Claim 15 under 35 U.S.C. § 102(b)

The Official Action states that claim 15 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,440,027 to Hasenhuettl.

As the basis of this rejection, the Official Action states:

> Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Hasenhuettl U.S. Patent 5,440,027 (Hasenhuettl).
> Hasenhuettl discloses a carbohydrate fatty acid produced via a solvent-free transesterification of acylated carbohydrates under reduced pressure, 1-500 mm Hg, at a temperature of 95-200° C in the presence of an acid catalyst (column 5, lines 56-68; column 3, lines 34-68; column 4, lines 1-2; column 9, lines 56-68; column 11, lines 2-21).

> Applicant's arguments filed October 21, 2003 have been fully considered but they are not persuasive.
> Applicant argues that the carbohydrate fatty acid of Hasenhuettl is produced by a different method. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Applicants respectfully traverse this rejection. The test for anticipation is whether each and every element as set forth is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicants thank the Examiner for the telephone conference of March 5, 2004, wherein the Examiner indicated that all the remaining dependent claims would be allowable if independent claim 1 was amended to include all the limitations of dependent claim 11. Applicants have amended claim 1 in accordance with the Examiner's suggestions to remove the present grounds for rejection.

Accordingly, applicants respectfully request the Examiner to reconsider and withdraw the rejection of pending claim 15.

3. Rejection of claims 1-6, 8-10, 13, 16, and 18-21 under 35 U.S.C. § 103(a)

The Office Action states that claims 1-6, 8-10, 13, 16, and 18-21 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,440,027 to Hasenhuettl in combination with D'Amato (U.S. Patent No. 3,054,789), Silver et al. (U.S. Patent No. 5,596,085), Matsumoto et al. (U.S. Patent No. 5,008,387), and Heesen et al. (U.S. Patent No. 3,951,945).

As the basis of this rejection, the Official Action states:

> Claims 1-6, 8-10, 13, 16, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasenhuettl U.S. Patent 5,440,027 (Hasenhuettl) in combination with D-Amato U.S. Patent 3,054,789 (D'Amato), Silver et al. U.S. Patent 5,596,085 (Silver), Matsumoto et al. U.S. Patent 5,008,387 (Matsumoto), and Heesen et al. U.S. Patent 3,951,945 (Heesen).
> Claim 1 is drawn to a process for preparing carbohydrate fatty-acid esters comprising: a) reacting acylated carbohydrate with free fatty acid in the presence of an acid catalysts under reduced pressure; b) decolorizing and separating out the unreacted fatty acid from the reaction mixture or step a); c) precipitating out the unreacted acylated carbohydrate from the reaction mixture obtained from step b); and d) recovering carbohydrate fatty ester from the reaction mixture obtained from step c). Claims 2-10, 13, 16, and 18-21 depend from claim 1. Claim 2 is drawn to a process wherein no solvent is added in step a). Claims 3 and 4 limit the manner in which the unreacted fatty acid is removed in step b). Claim 5 limits the temperature range for precipitating the unreacted acylated carbohydrate in step c). Claim 6 is drawn to a process wherein the unreacted farry acid and acylated carbohydrate is recycled. Claims 7-8 limit the pressure range wherein step a) is carried out. Claims 9-10 are drawn to HLB properties of the products produced. Claim 13 limits the temperature range in which step a) is performed. Claim 16 limits the carbohydrates employed in the process. Claim 18 limits the acid catalyst employed. Claims 19-20 limit the workup solvents. Claim 21 limits

the free fatty acids employed.

Hasenhuettl teaches the solvent-free transesterification of acylated carbohydrates under reduced pressure, 1-500 mm Hg, at a temperature of 95-200°C in the presence of an acid catalysts, which meets the sulfuric acid of claim 18 (column 5, lines 56-68; column 3, lines 34-68; column 4, lines 1-2; column 9, lines 56-68; column 11, lines 2-21). Saccharides disclosed as starting materials include glucose, sucrose, and raffinose along with other monosaccharides, disaccharides, and higher polysaccharides (column 7, lines 6-20). Suitable free fatty acids used in the process include butyric, lauric, palmitic, stearic, and oleic acids (column 8, lines 65-68; column 9, lines 1-18). Hasenhuettl further teaches that conventional purification techniques may be employed such as neutralization, dissolution into an organic solvent such as hexane, and decolorization with activated charcoal or hydrogen peroxide.

Hasenhuettl exemplifies purification of the products by distillation and filtration but lacks the recitation of separating the unreacted fatty acid and precipitating the unreacted acylated carbohydrate. Hasenhuettl teaches the use of partially acylated carbohydrates; however, Silver employs an identical process using partially or fully acylated carbohydrates (sucrose ocataacetate) (columns 5-10).

D'Amato teaches a process preparing pure sucrose fatty esters. D'Amato teaches that after removal of the catalyst and neutralization, the resulting mixture is continuously extracted with an organic solvent capable of dissolving the unreacted fatty acid lower alkyl ester or glyceride and the free fatty acid present in the medium, and in which the fatty acid sucrose ester is insoluble, and having a favorable partition coefficient (column 1, lines 61-72; column 2, lines 1-3).

Heesen teaches a method for purifying fatty acid esters of saccharides. Heesen teaches that non-esterified fatty acid can be removed by reaction with a bivalent cation with formation of insoluble calcium fatty acids salts and subsequent filtration, by treatment with ion exchange resins, by fractionated crystallization or a similar treatment, by (molecular) distillation (column 4, lines 15-21).

Matsumoto teaches a process for purifying sucrose fatty acid esters. Masumoto teaches that the removal of the unreacted sucrose from the reaction mixture containing sucrose fatty acid ester has been generally conducted by utilizing the property that sucrose is slightly soluble

in common organic solvents, namely by adding a solvent to the reaction mixture to precipitate the unreacted sucrose and removing the precipitate (column 1, lines 39-45).
It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare carbohydrate fatty-acid esters by a process comprising: a) reacting acylated carbohydrate with free fatty acid in the presence of an acid catalysts under reduced pressure; b) decolorizing and separating out the unreacted fatty acid from the reaction mixture or step a); c) precipitating out the unreacted acylated carbohydrate from the reaction mixture obtained from step b); and d) recovering carbohydrate fatty ester from the reaction mixture obtained from step c) as Hasenhuettl teaches the transesterification reaction and the product is purified using conventional means. The instantly claimed purification techniques are seen to be well within the purview of one of ordinary skill in the art at the time of the invention. The purification steps of the instantly claimed process are based on the solubility properties of the resultant reaction mixture. The use of solubility properties for purifying carbohydrate fatty acid esters is well known in the art. The choice of the appropriate solvents, pH, temperatures, and concentrations are seen to be well within the purview of the skilled artisan. The skilled artisan would readily recognize that the precipitation of a given compound is generally enhanced by lowering the temperature of the solution in which it is contained. The specific condition manipulated in order to affect the solubility of a given compound is seen to be a choice of experimental design. It would also have been obvious to one of ordinary skill in the art to recycle the unreacted components of the reaction mixture as it is well established that batch and continuous processes are not patentably distinct. The recitation of HLB values of the product produced is not seen to add any patentable weight to the instantly claimed process as all of the process steps for preparing the carbohydrate fatty acid esters are taught in the art. Where the steps of a process are the same as the prior art, and the only difference is in the recital of the product produced, the process is unpatentable over the prior art.
Applicant's arguments filed October 21, 2003 have been fully considered but they are not persuasive.
Applicant argues that all the claim limitations are not present in the cited references and one of ordinary skill in the art would have no motivation to modify the cited

references into the present invention. Specifically, applicant argues that both Hasenhuettl and Silver disclose methods for preparing saccharide fatty acid polyesters by first conducting an esterification, then conducting trans-alcoholysis or transesterification. Applicant also comments on the unexpected advantages of the transesterification process disclosed by the prior art; however, these comments are not seen to be germane to the rejections of record, as none of the asserted "advantages" recited as claim limitations.

The examiner disagrees with applicant's characterization of the art of record. Hasenhuettl teaches solvent-free transesterification of acylated carbohydrates under reduced pressure, 1-500 mm Hg, at a temperature of 95-200^0 C in the presence of an acid catalyst (column 5, lines 56-68; column 3, lines 34-68; column 4, lines 1-2; column 9, lines 56-68; column 11, lines 2-21). Applicant's attention is directed to column 3, lines 34-68; column 8, lines 38-67; and column 9, lines 1-32, wherein Hasenhuettl teaches partially esterified saccharide is transesterified with a fatty-acid containing reagent selected from the group consisting of fatty acids, fatty acid salts, lower alkyl esters, and fatty acid anhydrides. The examiner acknowledges that the process of Hasenhuettl employs two steps. In the first step a saccharide is converted into a partially esterified saccharide, In the second step, the partially esterified saccharide is transesterified with a fatty-acid containing reagent. However, the method as instantly claimed does not exclude additional methodological steps. In the absence of some proof of a secondary nature to obviate the rejection as set forth in the Office Action dated May 28, 2003, or of some specific limitations which would tip the scale of patentability in favor of the instantly claimed invention, it would have been obvious to one of ordinary skill in this art at the time of the invention to prepare carbohydrate fatty-acid esters employing a method comprising: a) reacting acylated carbohydrate with free fatty acid in the presence of an acid catalysts under reduced pressure; b) decolorizing and separating out the unreacted fatty acid from the reaction mixture or step a); c) precipitating out the unreacted acylated carbohydrate from the reaction mixtures obtained from step b); and d) recovering carbohydrate fatty ester from the reaction mixture obtained from step c).

Applicants respectfully traverse this rejection because all three prongs for a *prima facie* case of obviousness have not been established for each of the rejections. Specifically, all the claim limitations are not present in the cited references and one of ordinary skill in the art would have no motivation to modify the cited references into the present invention.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all the claim limitations. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); Amgen, Inc. v. Chugai Pharm. Co., 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); In re Wilson, 165 USPQ 494, 496 (C.C.P.A. 1970).

A *prima facie* case of obviousness must also include a showing of the reasons why it would be obvious to modify the references to produce the present invention. See Ex parte Clapp, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner bears the initial burden to provide some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. Id. at 974.

Applicants thank the Examiner for the telephone conference of March 5, 2004, wherein the Examiner indicated that all the pending claims would be allowable if independent claim 1 was amended to include all the limitations of dependent claim 11. Applicants have

amended claim 1 in accordance with the Examiner's suggestions to remove the present grounds for rejection.

Accordingly, applicants respectfully submit that the presently claimed invention is unobvious over Hasenhuettl in view of Silver et al., Matsumoto et al., Heesen et al., and D'Amato et al. and respectfully request the Examiner to reconsider and withdraw the rejection of presently pending claims 1-6, 8-10, 13, 16, and 18-21.

4. Rejection of claim 17 under 35 U.S.C. § 103(a)

The Office Action states that claim 17 is rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,440,027 to Hasenhuettl in combination with D'Amato (U.S. Patent No. 3,054,789), Silver et al. (U.S. Patent No. 5,596,085), Matsumoto et al. (U.S. Patent No. 5,008,387), and Heesen et al. (U.S. Patent No. 3,951,945).

As the basis of this rejection, the Official Action states:

> Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hasenhuettl U.S. Patent 5,440,027 (Hasenhuettl) in combination with D-Amato U.S. Patent 3,054,789 (D'Amato), Silver et al. U.S. Patent 5,596,085 (Silver), Matsumoto et al. U.S. Patent 5,008,387 (Matsumoto), and Heesen et al. U.S. Patent 3,951,945 (Heesen).
> Claim 17 is drawn to a process for preparing carbohydrate fatty-acid esters comprising: a) reacting acylated carbohydrate with free fatty acid in the presence of an acid catalysts under reduced pressure; b) decolorizing and separating out the unreacted fatty acid from the reaction mixture or step a); c) precipitating out the unreacted acylated carbohydrate from the reaction mixture obtained from step b); and d) recovering carbohydrate fatty ester from the reaction mixture obtained from step c), wherein the acyl group in the reactant acylated carbohydrates is acetic or propanoic acyl group.

Hasenhuettl teaches the solvent-free transesterification of acylated carbohydrates under reduced pressure, 1-500 mm Hg, at a temperature of 95-200°C in the presence of an acid catalysts, which meets the sulfuric acid of claim 18 (column 5, lines 56-68; column 3, lines 34-68; column 4, lines 1-2; column 9, lines 56-68; column 11, lines 2-21). Saccharides disclosed as starting materials include glucose, sucrose, and raffinose along with other monosaccharides, disaccharides, and higher polysaccharides (column 7, lines 6-20). Suitable free fatty acids used in the process include butyric, lauric, palmitic, stearic, and oleic acids (column 8, lines 65-68; column 9, lines 1-18). Hasenhuettl further teaches that conventional purification techniques may be employed such as neutralization, dissolution into an organic solvent such as hexane, and decolorization with activated charcoal or hydrogen peroxide.

Hasenhuettl exemplifies purification of the products by distillation and filtration but lacks the recitation of separating the unreacted fatty acid and precipitating the unreacted acylated carbohydrate. Hasenhuettl teaches the use of partially acylated carbohydrates; however, Silver employs an identical process using partially or fully acylated carbohydrates (sucrose ocataacetate) (columns 5-10).

D'Amato teaches a process preparing pure sucrose fatty esters. D'Amato teaches that after removal of the catalyst and neutralization, the resulting mixture is continuously extracted with an organic solvent capable of dissolving the unreacted fatty acid lower alkyl ester or glyceride and the free fatty acid present in the medium, and in which the fatty acid sucrose ester is insoluble, and having a favorable partition coefficient (column 1, lines 61-72; column 2, lines 1-3).

Heesen teaches a method for purifying fatty acid esters of saccharides. Heesen teaches that non-esterified fatty acid can be removed by reaction with a bivalent cation with formation of insoluble calcium fatty acids salts and subsequent filtration, by treatment with ion exchange resins, by fractionated crystallization or a similar treatment, by (molecular) distillation (column 4, lines 15-21).

Matsumoto teaches a process for purifying sucrose fatty acid esters. Masumoto teaches that the removal of the unreacted sucrose from the reaction mixture containing sucrose fatty acid ester has been generally conducted by utilizing the property that sucrose is slightly soluble in common organic solvents, namely by adding a solvent to

the reaction mixture to precipitate the unreacted sucrose and removing the precipitate (column 1, lines 39-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare carbohydrate fatty-acid esters by a process comprising: a) reacting acylated carbohydrate with free fatty acid in the presence of an acid catalysts under reduced pressure; b) decolorizing and separating out the unreacted fatty acid from the reaction mixture or step a); c) precipitating out the unreacted acylated carbohydrate from the reaction mixture obtained from step b); and d) recovering carbohydrate fatty ester from the reaction mixture obtained from step c) as Hasenhuettl teaches the transesterification reaction and the product is purified using conventional means. The instantly claimed purification techniques are seen to be well within the purview of one of ordinary skill in the art at the time of the invention. The purification steps of the instantly claimed process are based on the solubility properties of the resultant reaction mixture. The use of solubility properties for purifying carbohydrate fatty acid esters is well known in the art. The choice of the appropriate solvents, pH, temperatures, and concentrations are seen to be well within the purview of the skilled artisan. The skilled artisan would readily recognize that the precipitation of a given compound is generally enhanced by lowering the temperature of the solution in which it is contained. The specific condition manipulated in order to affect the solubility of a given compound is seen to be a choice of experimental design. It would also have been obvious to one of ordinary skill in the art to recycle the unreacted components of the reaction mixture as it is well established that batch and continuous processes are not patentably distinct. The recitation of HLB values of the product produced is not seen to add any patentable weight to the instantly claimed process as all of the process steps for preparing the carbohydrate fatty acid esters are taught in the art. Where the steps of a process are the same as the prior art, and the only difference is in the recital of the product produced, the process is unpatentable over the prior art.

Applicants respectfully traverse this rejection because all three prongs for a *prima facie* case of obviousness have not been established for each of the rejections. Specifically, all the

claim limitations are not present in the cited references and one of ordinary skill in the art would have no motivation to modify the cited references into the present invention.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all the claim limitations. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); Amgen, Inc. v. Chugai Pharm. Co., 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); In re Wilson, 165 USPQ 494, 496 (C.C.P.A. 1970).

A *prima facie* case of obviousness must also include a showing of the reasons why it would be obvious to modify the references to produce the present invention. See Ex parte Clapp, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner bears the initial burden to provide some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. Id. at 974.

Applicants thank the Examiner for the telephone conference of March 5, 2004, wherein the Examiner indicated that all the pending claims would be allowable if independent claim 1, from which claim 17 depends, was amended to include all the limitations of dependent claim 11. Applicants have amended claim 1 in accordance with the Examiner's suggestions to remove the present grounds for rejection.

Accordingly, applicants respectfully submit that the presently claimed invention is unobvious over Hasenhuettl in view of Silver et al., Matsumoto et al., Heesen et al., and D'Amato et al. and respectfully request the Examiner to reconsider and withdraw the rejection of presently pending claim 17.

CONCLUSION

In light of the foregoing, applicants submit that the application is now in condition for allowance. The Examiner is therefore respectfully requested to reconsider and withdraw the rejection of all pending claims 1-6, 8-10, and 12-23 and allow these claims. Favorable action with an early allowance of the claims is earnestly solicited.

Respectfully submitted,

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March 15, 2004

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This is to certify that the annexed is a true copy of specification as filed for the following Singapore patent application.

Date of Filing	:	24 FEBRUARY 2001
Application Number	:	200100727-7
Applicant(s) / Proprietor(s) of Patent	:	URAH RESOURCES (NIGERIA) LTD; OLOBO JONATHAN OBAJE
Title of Invention	:	SOLVENT-FREE TRANS-ACIDOLYSIS PROCESS FOR THE PREPARATION OF EDIBLE SURFACE-ACTIVE CARBOHYDRATE FATTY-ACID ESTERS

SHARMAINE WU (Ms)
Assistant Registrar
for REGISTRAR OF PATENTS

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Attorney Docket No. 82489

Date: 21 Oct 03

Attorney: HLN/TLJ/JBG

OIPE JC174
OCT 21 2003
PATENT & TRADEMARK OFFICE

Inventors: OBAJE

Serial No. 10/167,458

Filed: January 15, 2002

Title: **TRANS-ACIDOLYSIS PROCESS FOR THE PREPARATION OF CARBOHYDRATE FATTY-ACID ESTERS**

THE PTO STAMP HEREON ACKNOWLEDGES RECEIPT OF:

(1) Transmittal Letter;
(2) Response to Office Action;
(3) Petition for Two-Month extension of time;
(4) Check No. 19635 in the amount of $420.00; and
(5) Certified Copy of Foreign Priority Appln., SG 200100727-7.

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